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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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PATENT APPLICATION

ATTORNEY DOCKET NO. 200315755-1

Inventor(s): Vanessa I Chinea-Hernandez

Confirmation No.: 1334

Application No.: 10/800533

Examiner: Levest D. Jones

Filing Date: Mar 15, 2004

Group Art Unit: 1618

Title: Pharmaceutical Vehicle

Mail Stop
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment
☐ New fee as calculated below
☒ No additional fee
☒ Other Response to Restriction Requirement

- ☐ Petition to extend time to respond
☐ Supplemental Declaration

Fee\$

| CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY | | | | | | |
|---|---|---|--|--|-------------|---------------------------|
| (1) FOR | (2) CLAIMS REMAINING AFTER AMENDMENT | (3) NUMBER EXTRA | (4) HIGHEST NUMBER PREVIOUSLY PAID FOR | (5) PRESENT EXTRA | (6) RATE | (7) ADDITIONAL FEES |
| TOTAL CLAIMS | | MINUS | | = 0 | X \$50 | \$ 0 |
| INDEP. CLAIMS | | MINUS | | = 0 | X \$200 | \$ 0 |
| <input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM | | | | | + \$360 | \$ 0 |
| EXTENSION FEE | <input type="checkbox"/> 1st Month \$120 | <input type="checkbox"/> 2nd Month \$450 | <input type="checkbox"/> 3rd Month \$1020 | <input type="checkbox"/> 4th Month \$1590 | | \$ 0 |
| OTHER FEES | | | | | | \$ |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | | \$ 0 |

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Date of Deposit: Apr 10, 2006

Typed Name: Donald J. Coulman

Signature: [Signature]

Respectfully submitted,

Vanessa I Chinea-Hernandez

By [Signature]

Donald J. Coulman

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Date : Apr 10, 2006

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PATENT APPLICATION

Attorney Docket No: 200315755-1



**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventors: Vanessa I. China **Examiner:** Levest D. Jones
Application No: 10/800,533 **Group Art Unit:** 1618
Filing Date: March 15, 2004 **Confirmation No:** 1334
Title: PHARMACEUTICAL VEHICLE

COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In response to Examiner's Office Communication dated March 9, 2006 Applicant responds as follows:

Examiner has identified six distinct inventions:

- I. Claims 1-3, drawn to a method of dispensing a pharmaceutical, classified in class 424, subclass 400+;
- II. Claims 4-5, drawn to a method of producing pharmaceutical doses, classified in class 424, subclass 1.11+;
- III. Claims 6-9, drawn to a pharmaceutical solution, classified in class 424, subclass 1.65+;
- IV. Claims 10-15, drawn to a method of forming a pharmaceutical dose, classified in class 424, subclass 1.11+;
- V. Claims 16-18, drawn to a fluid ejection device classified in class 424, subclass 400+; and
- VI. Claims 19-24, drawn to a fluid ejection device, classified in class 424, subclass 400+.

Applicant respectfully traverses Examiner's restriction. Applicant believes that the restriction requirement is improper for several reasons. First, Applicant believes that the six groups identified by the Examiner may be patentably distinct. However,

Applicant notes Examiner has not provided any argument that the six groups are independent as required by 35 U.S.C. §121 which states "[i]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." *Emphasis added*. Applicant further notes that 35 U.S.C. preempts 37 C.F.R. which preempts the MPEP. Thus, Applicant believes Examiner has not established a prima facie case for restricting the claims of the application based on the lack of a reasoned argument how the groups asserted to be distinct are independent and distinct as required by 35 U.S.C. §121.

Second, as noted above Applicant believes that the six groups identified by the Examiner may be patentably distinct. However, Examiner must provide a reasoned explanation why the inventions as claimed are distinct as well as explaining why the distinct inventions must be restricted on the basis of either a separate classification, a separate status in the art, or a different field of search. With out any explanation by Examiner Applicant is left guessing whether Examiner has made a proper restriction and whether the groups are indeed patentably distinct. Applicant believes that Applicant should not have to guess as to what are the patentably distinct features in the claims that the Examiner has identified. Examiner in identifying groups I-VI has provided no reasoned argument or explanation how each group identified is a distinct group. As just one example, Examiner has provided no explanation how Group V is distinct from Group VI since both groups are in the same class and subclass. Applicant traverses Examiner's statement that some claims are in the same class/subclass, the limitations present in the claims are distinct from each other and therefore requires a separate search. Applicant believes that such a statement is simply a conclusory statement that could apply to every claim and does not present any reasoned explanation and does not provide any identification of the limitations which Examiner views as distinct. Applicant requests that Examiner provide a reasoned argument how each of the 6 groups is distinct from the other groups. Further, Applicant traverses Examiner's statement on page 3 that the pharmaceutical composition may be used in the methods of Groups I, II, V, and VI. Applicant notes that Groups V and VI, according to Examiner, are claims drawn to an apparatus and are not method claims. Applicant believes Examiner has not established a prima facie case for restricting the claims of the application because of the lack of any reasoned

argument. In addition, Applicant requests that Examiner provide authority for restricting an application when the claims appear in the same class/subclass. Further, Applicant requests that Examiner identify each limitation in the claims that are distinct from each other and therefore require a separate search which cannot be done within the standard search strategy.

Third, Examiner's restriction requirement has not established that an undue burden would be required if the restriction requirement either was not issued or if issued with fewer groups. More particularly, MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application, Examiner has not established any undue burden if each of the claims were examined together or if examined in a smaller number of groups. In particular Examiner has neither indicated nor has given any arguments as to why prosecution of claims to Groups I, V, and VI and claims to Groups II and IV presents any serious burden as required by MPEP §803. Again Applicant notes that merely because a limitation may be distinct from another limitation does not per se create a prima facie case for restriction by itself.

Fourth, Applicant is confused as to what species Applicant is required to elect. Examiner on page 3 of the Office Communication states in item number 4 that claims 1-24 are generic to the following disclosed patentably distinct species without listing any species. Examiner then states that Applicant is required to elect a single disclosed species. Applicant asserts that Examiner's restriction requirement based on patentably distinct species is improper for failure to disclose any species whether patentably distinct or not. Applicant believes that Applicant's election of a particular group is being fully responsive to this requirement for restriction.

The present restriction requirement not only improperly shifts the Examiner's burden to Applicant, but also subjects Applicant to the added financial burden of prosecuting different claims in an unreasonable number of separate proceedings. Applicant

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respectfully requests that Examiner reconsider the current restriction and withdraw this restriction requirement.

Thus, Applicant hereby provisionally elects with traverse Group III covering claims 6-9 in class 424, subclass 1.65+. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional, continuation, and/or continuation-in-part applications that cover the non-elected claims.

The examiner has required restriction between product and process claims. Where Applicant elects claims drawn to the product, and the product claims are subsequently found allowable, withdrawn method claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of MPEP §821.04. Method claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

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Respectfully submitted,
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